

The opinion in support of the decision being entered today was not
written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte FRANK J. BOVA and WILLIAM A. FRIEDMAN

Appeal No. 2005-1658
Application No. 09/430,034

ON BRIEF

MAILED

SEP 28 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before MCQUADE, CRAWFORD, and BAHR, Administrative Patent Judges.

CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 23, which are all of the claims pending in this application.

We reverse.

BACKGROUND

The appellants' invention relates to a device, system and method for stereotactic medical procedures which includes a mechanically free locator (specification, pages 1 and 6). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

THE PRIOR ART REFERENCES

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

McLaurin, Jr.	5,370,117	Dec. 6, 1994
Kormos et al. (Kormos)	5,682,890	Nov. 4, 1997

THE REJECTIONS

Claims 9, 15 to 16, 19 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kormos.

Claims 1 to 8, 10 to 14, 17 to 18 and 20 to 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kormos in view of McLaurin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed Jul. 12, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (filed May 3, 2002) and reply brief (filed Nov. 20, 2002) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We turn first to the examiner's rejection of claims 9, 15 to 16, 19 and 23 under 35 U.S.C. § 102 as being anticipated by Kormos. We initially note that to support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The examiner is of the opinion that Kormos describes the invention as recited in claim 9. In regard to the various limitations in claim 9 that the locator is "mechanically free," the examiner relies on col. 3, lines 3 to 34. This portion of the Kormos reference reads, in relevant part:

Other exoskeleton materials are also contemplated. For example, a plaster impregnated gauze type material may be wet, molded into place, affixed to the base or table, and allowed to cure or set. As another alternative, the exoskeleton material can be a mesh of very stiff but pliable elastic mesh which is sufficiently stiff to hold the soft tissue substantially fixed relative to itself. [Emphasis added; col. 3, lines 21 to 27.]

In the examiner's view, this passage discloses that the material described is so stiff it does not need affixation means and is thus mechanically free.

The appellants argue that Kormos does not describe a locator which is mechanically free.

Kormos describes a process by which a first material is a flexible sheet that is immersed in hot water, allowed to cool then stretched over and molded to the soft tissue of the patient (col. 3, lines 9 to 14). The material which forms the locator is then affixed to the sides of the patient support.

Kormos also describes a second material to form the locator which is a plaster impregnated gauze material which is wet, molded in place and then affixed to the patient support (col. 3, lines 21 to 24).

Finally, Kormos describes a third material to form the locator which is a mesh of very stiff material which is pliable enough to be molded to the soft tissue of the patient but is stiff enough to be molded to the soft tissue without prior wetting. Kormos does not specifically state that a locator made of this third material is affixed to the support. However, in our view, this portion of the Kormos reference relates to a difference in the material which comprises the locator not a locator that requires no support. The examiner's finding to the contrary lacks sound factual basis, and is at best speculative.

Accordingly, we shall not sustain this rejection as it is directed to claim 9. We will also not sustain this rejection as it is directed to claims 15, 19, 16 and 23 dependent thereon, as claims 15 and 19 each require that the locator is mechanically free.

We turn next to the examiner's rejection of claims 1 to 8, 10 to 14, 17 to 18 and 20 to 22 as being unpatentable over Kormos in view of McLaurin. The examiner relies on McLaurin for teaching that the method is used for repeated imaging and therapy.

Claims 1, 9, 14 and 15 and claims 2 to 8, 10 to 13, 17 to 18, 20 to 22 dependent thereon, each require a mechanically free locator. Kormos does not describe or suggest a mechanically free locator. McLaurin does not describe or suggest a mechanically free locator. Therefore, we will not sustain this rejection.

The decision of the examiner to reject claims 1 to 23 under 35 U.S.C. § 102 and 35 U.S.C. § 103 is reversed.

REVERSED


JOHN P. MCQUADE

JOHN P. MCQUADE
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge

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JENNIFER D. BAHR
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